COMMENTS

Applicants appreciate the Examiner's withdrawal of the previous rejections of claims 12-16 under 35 U.S.C. §112, second paragraph; of claims 12-16 under 35 U.S.C. §103; and the new matter rejection.

Double Patenting Rejections

Claims 12-16 have been rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-13 of U.S. Patent No. 5,563,067. In particular, the Office Action states:

> "Although the conflicting claims are not identical, they are not patentably distinct from each other because both claims of the instant application and those of U.S. Patent No. 5,563,067 are drawn to apparatus and a method for measuring the electrical and physical characteristic of cells. While 1-13 of U.S. Patent No. 5,563,067 specifically recite and apparatus for measurement of electrical and physical characteristic of cells, it does not specifically recite measuring the properties of tissue with or without addition of medicines. However, it would have been obvious to one of ordinary skill in the art to substitute any tissue as recited in the claimed methods and device in order to measure electrical and physical properties of tissue with or without addition of medicines"

Applicants disagree. It is believed that the manner or method in which the device found in the '067 patent is used, is not necessarily obvious from a mere statement of the device claims in that patent. Applicants have claimed a complex procedure which is not apparent from the device itself. Nevertheless, applicants are submitting with this Amendment, a Terminal Disclaimer in an effort to hasten examination to a successful conclusion. Consequently, allowance of the application is believed to be in order.

Such allowance is requested.

PRIOR ART DISCUSSION

Applicants' attorney agreed to explain the concern had about the Kokai (published Japanese application) and the published European application corresponding to the '067 Patent.

In any event, the Kokai corresponding to the '067 Patent was published in March of 1996. The published European application became a public document on December 27, 1995.

The current application (Ser. No. 08/913,811) was filed on September 24, 1997. It is a 35 U.S.C. §371 application based on a PCT application filed on January 24, 1997, which in turn has, as its priority document, a Japanese application filed in January of 1996. The current application also claims priority from U.S. application having Serial No. 662,629, filed on ~~January 24, 1996~~ June 13 96, which in turn, is a CIP of U.S. Ser. No. 08/464,116, filed June 5, 1995.

The summation of all of this is that the Kokai was filed two months after the priority document in Japan. The Kokai is not prior art under the statute.

The European publication was published prior to either of the '629 U.S. priority document or the Japanese priority document. However, the European publication date was less than a month prior to the filing date of the parent or priority documents. Consequently, the European publication does not serve as a reference under 35 U.S.C. §102(b). Similarly, the parent application of the '629 application was filed prior to the European publication date. The '116 parent to this case obviates the basis for any rejections under 35 U.S.C. §102(a) or (b).

Since there is no statutory basis for an anticipation rejection under 35 U.S.C. §102, there similarly can be no rejection under 35 U.S.C. §103.

Consequently, our earlier concern of a previously unidentified reference was unfounded.

CONCLUSION

Applicants have responded to each issue of substance raised in the Office Action. Allowance of the application is now requested. Should the Examiner have any additional comments, questions, or requests, she is invited to contact applicants' attorney at the number listed below. Should a personal or telephonic interview be desired, again, please contact applicants' attorney and accommodation will be made.

Respectfully submitted,

Dated: April 5, 2001

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ATTACHMENT SHOWING AMENDMENTS TO THE CLAIMS

Please cancel claims 13 and 15 without prejudice to their later renewal and without acquiescing to any outstanding rejections.

Please amend claim 12 as follows:

12. (four times amended) A method of testing the chronic effect on neural or muscle tissue samples of chemical substances, which comprises:

providing a detector comprising a plurality of microelectrodes on a substrate, [which plurality of microelectrodes are coated with a covering for increasing the adhesion of said neural or muscle tissue samples to said plurality of microelectrodes,] for contacting the tissue sample and detecting an electrical property of said tissue sample to which a chemical substance has been added and said plurality of microelectrodes further for applying an electric stimulus to the tissue sample;

[providing an image detection system for observing the visible properties of the tissue sample from outside;]

contacting said neural or muscle tissue sample with a plurality of said electrodes;

measuring the electrical [or visible] properties of the neural or muscle tissue sample;

adding said chemical substance to the neural or muscle tissue sample;

measuring the electrical [or visible] properties of the neural or muscle tissue sample after said addition of said chemical substance to the neural or muscle tissue sample and at a time which measures chronic response to said chemical substance; and

comparing said electrical [or visible] properties before and after said addition of said chemical substance to determine whether said added chemical substance has had an influence on the neural or muscle tissue sample.

Please amend claim 14 as follows:

14. (amended) The method of claim 12 for testing the effect on neural or muscle tissue samples of chemical substances as medicines, wherein the step of adding chemical substance to the neural or muscle tissue sample comprises adding said chemical substance in a selected [an arbitrary] concentration to the neural or muscle tissue sample.

Please amend claim 16 as follows:

16. The method of claim 12 for testing the effect on neural or muscle tissue samples of chemical substances as medicines, wherein the chronic measuring step takes place at least three days after said addition step.